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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,117	07/09/2003	Rian R. Maloney	021768.1200	2197
5073	7590	08/20/2004	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			RODRIGUEZ, JOSEPH C	
		ART UNIT	PAPER NUMBER	
		3653		

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/616,117	MALONEY, RIAN R.
	Examiner Joseph C Rodriguez	Art Unit 3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 29-41 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11, 14-25 and 28 is/are rejected.
- 7) Claim(s) 12, 13, 26 and 27 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/9/03, 12/5/03
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28, drawn to a method and system for handling checks, classified in class 700, subclass 223.
- II. Claims 29-38, drawn to a method and system for code line matching, classified in class 382, subclass 139.
- III. Claims 39-41, drawn to a system for handling checks that generates feature instructions to a sorter, classified in class 209, subclass 583.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). Here, the claimed processes can be practiced by materially different devices (e.g., devices not communicating with a check processing system over a TCP/IP connection).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Chuck Fish on August 17, 2004 a provisional election was made without traverse to prosecute the invention of group I,

claims 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 10, 11, 14-18, 24, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef et al. ("Graef") (US '682) in view of Green et al. ("Green") (US '936).

Graef teaches a method and system for handling checks comprising retrieving MICR data from a check (col. 20, ln. 1-31); performing a search of code line data for a match based on the MICR data (Id.); determining a plurality of feature instructions from the code line data if a match exists (Id.); executing an executable code file to generate results based on the MICR data if no match exists (col. 20, ln. 34-54); determining a plurality of feature instructions from the results (col. 20, ln. 58-65); and communicating with a check processing system (col. 20, ln. 23-65, check processing system is regarded as inherent in external financial institution). Here, the searching and subsequent scanning of the appropriate MICR codes in the designated reading locations is regarded as the matching of code line data, thus the repositioning routine

when no match occurs (i.e., no MICR data found in designated location that matches a stored identifier such as account number) is regarded as the step that produced matching MICR results. Further, the feature instructions are regarded as the "instructions" given by the central computer or by the check processing system of the external financial institution (col. 20, ln. 58-65).

Further, the MICR information taught by Graef is regarded as standardized for a plurality of disparate check sorters as it contains standard features, such as account number and check number (col. 20, ln. 10-20). Graef further teaches said data compatible with a check sorter and processing system (col. 20, ln. 53-65).

Graef as set forth above thus teaches all that is claimed except for expressly teaching communicating with the check processing system in real-time over a TCP/IP connection. Graef, however, already teaches a connection to an external institution. Further, Green teaches that MICR reader/sorters usually connect to externally located check processing systems using the TCP/IP protocol (Fig. 4, 6; col. 8, ln. 23-54). Moreover, this type of connection allows documents to be more easily processed and handled remotely by a check processing system (col. 3, ln. 39-45). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Graef as taught by Green above to allow remote access to a check processing system.

Claims 6-9 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef in view of Green as applied to claims 1-5, 10, 11, 14-18, 24, 25 and 28 above, and further in view of Dinan et al. ("Dinan") (US '483).

Graef in view of Green as set forth above thus teach all that is claimed except for expressly teaching instructions comprising endorsing, microfilming, or a variety digital imaging options during check handling. These types of instructions, however, are common check processing steps. Dinan expressly teaches that these check processing steps are well known in the check processing arts to assist in archiving the check during processing (col. 1, ln. 8-col. 2, ln. 12). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Graef in view of Green with check processing steps that are well known in the art.

Allowable Subject Matter

Claims 12-13 and 26-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Here, the system taught by Cahill (US '377) in figures 1 and 3 should be noted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is **703-308-8342**. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The **UnOfficial** fax phone number for the organization where this application or proceeding is assigned is **703-306-2571** or **703-308-6552**.

The examiner's **UNOFFICIAL Personal fax number** is **703-746-3678**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

<http://pair-direct.uspto.gov>

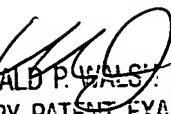
Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **703-308-1113**.

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August 17, 2004


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